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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,195	07/24/2001	David D. Landron	1220	5687

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SYMBOL TECHNOLOGIES INC
LEGAL DEPARTMENT
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HOLTSVILLE, NY 11742

EXAMINER

MASON, DONNA K

ART UNIT PAPER NUMBER

2111

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,195

Applicant(s)

LANDRON ET AL.

Examiner

Donna K. Mason

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 257
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

On page 1, line 7, insert the appropriate serial number associated with the related application, entitled, *Adapter Unit Having an Ergonomic Grip for a Personal Digital Assistant*.

Appropriate correction is required. See 37 CFR 1.71.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 1 recites the limitation "the PDA's processor" in line 15. There is insufficient antecedent basis for this limitation in the claim. The examiner recommends inserting --(PDA)-- after "personal digital assistant" in claim 1, line 2. The examiner further recommends reviewing each of claims 1-28 to ensure consistency in the usage of the terms "personal digital assistant" and "PDA."
5. Claim 3 recites the limitation "said determining step" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim. (It should be noted that for

examination purposes, claim 3 has been interpreted such that "said determining step" is replaced with --said disengaging step--).

6. Dependent claims 2 and 4-11 inherit the deficiencies of independent claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 8-15, 20-23, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,512,467 to Hanks, et al. ("Hanks").

With regard to claims 1, 12, and 22, Hanks discloses a method and system for automatically changing the functionality of an application button on a personal digital assistant (PDA) from a first function to a second function (column 2, lines 26-28), where the PDA has a processor and an expansion connector. The method includes the steps of providing an adapter unit for engaging with the PDA (column 3, lines 19-20), storing in the adapter a configuration agent for changing the functionality of the application button from the first function to the second function (column 3, lines 27-28), securing the adapter unit to the PDA, such that the information stored in the configuration agent is communicated to the PDA (column 3, lines 34-44), processing in the PDA's processor

the information stored in the configuration agent, and automatically changing the functionality of the application button from the first function to the second function (column 3, lines 53-55).

With regard to claims 2, 13, and 22, Hanco discloses the method and system further including the steps of storing a polling agent on the PDA, and determining whether the expansion connector is engaged with the adapter connector (column 3, lines 18-19).

With regard to claims 3 and 28, Hanco discloses the method and system further including the step of disengaging the expansion connector from the adapter connector and automatically changing the functionality button from the second function to the first function (column 4, lines 17-20).

With regard to claims 8, 9, 11, 14, 15, 21, and 23, Hanco discloses the method and system where the information stored in the configuration agent is a program, the program changes application button mappings within the PDA, and the information in the configuration agent includes reconfiguration data for use by the PDA's processor (column 3, lines 59-61).

With regard to claims 10, 20, and 22, Hanco discloses the method and system where the information stored in the configuration agent includes an identification code for identifying the adapter unit (column 3, lines 45-52).

Therefore, Hanco reads on the on the invention as claimed.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-6, 16-18, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanco in view of U.S. Patent No. 6,065,880 to Thompson.

As described above, with regard to the 35 U.S.C. 102(e) rejection of independent claims 1, 12, and 22, Hanco discloses all the features of those claims. However, Hanco does not expressly disclose all the features of dependent claims 4-6.

Thompson discloses the method and system where the adapter unit includes a product identification reader, where the second function relates to a trigger for activating the product identification reader, where the product identification reader is a bar code reader, and where the product identification reader is an imager (see column 2, lines 5-20 and column 4, lines 52-67).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the product identification reader, bar code reader, or imager of Thompson with the method and system of Hanco. The suggestion or motivation for doing so would have been to increase the functionality of the PDA, for example, such that the PDA can be effectively used for monitoring or controlling inventory or other products on which bar codes or other images can be positioned (see Thompson, column 2, lines 16-21).

Therefore, it would have been obvious to combine Thompson with Hanko to obtain the invention as specified in claims 4-6, 16-18, and 24-26.

11. Claims 7, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanko in view of U.S. Patent Application Publication No. 2003/0181168 to Herrod, et al. ("Herrod").

As described above, with regard to the 35 U.S.C. 102(e) rejection of independent claims 1, 12, and 22, Hanko discloses all the features of those claims. However, Hanko does not expressly disclose all the features of dependent claims 7, 19, and 27.

Herrod discloses the method and system where the adapter unit includes a wireless radio and where the second function relates to transmitting information over the wireless radio (page 4, paragraph [0080]).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the wireless radio of Herrod with the method and system of Hanko. The suggestion or motivation for doing so would have been to increase portability of the PDA.

Therefore, it would have been obvious to combine Herrod with Hanko to obtain the invention as specified in claims 7, 19, and 27.

Conclusion

12. A shortened statutory period for reply is set to expire THREE MONTHS from the mailing date of this communication. Extensions of time may be available under the


provisions of 37 CFR 1.136(a). In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna K. Mason whose telephone number is (703) 305-1887. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

DKM


XUAN M. THAI
PRIMARY EXAMINER
TC 1100